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Description' Requirement, ' 64 FR 71427, Dec. 21, 1999; 1231 O.G. 123, Feb. 29, 2000, which raised issues pertinent to the utility requirement are also addressed below.

Responses to Specific Comments

(1) Comment: Several comments state that while inventions are patentable, discoveries are not patentable. According to the comments, genes are discoveries rather than inventions. These comments urge the USPTO not to issue patents for genes on the ground that genes are not inventions. Response: The suggestion is not adopted. An inventor can patent a discovery when the patent application satisfies the statutory requirements. The U.S. Constitution uses the word 'discoveries' where it authorizes Congress to promote progress made by inventors. The pertinent part of the Constitution is Article 1, section 8, clause 8, which reads: 'The Congress shall have power * * * To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.'

When Congress enacted the patent statutes, it specifically authorized issuing a patent to a person who 'invents or discovers' a new and useful composition of matter, among other things. The pertinent statute is 35 U.S.C. 101, which reads: 'Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.' Thus, an inventor's discovery of a gene can be the basis for a patent on the genetic composition isolated from its natural state and processed through purifying steps that separate the gene from other molecules naturally associated with it.

If a patent application discloses only nucleic acid molecular structure for a newly discovered gene, and no utility for the claimed isolated gene, the claimed invention is not patentable. But when the inventor also discloses how to use the purified gene isolated from its natural state, the application satisfies the 'utility' requirement. That is, where the application discloses a specific, substantial, and credible utility for the claimed isolated and purified gene, the isolated and purified gene composition may be patentable.

(2) Comment: Several comments state that a gene is not a new composition of matter because it exists in nature, and/or that an inventor who isolates a gene does not actually invent or discover a patentable composition because the gene exists in nature. These comments urge the USPTO not to issue patents for genes on the ground that genes are products of nature. Others state that naturally occurring DNAs are part of our heritage and are not inventions. Another comment expressed concern that a person whose body includes a patented gene could be guilty of patent infringement. Response: The comments are not adopted. A patent claim directed to an isolated and purified DNA molecule could cover, e.g., a gene excised from a natural chromosome or a synthesized DNA molecule. An isolated and purified DNA molecule that has the same sequence as a naturally occurring gene is eligible for a patent because (1) an excised gene is eligible for a patent as a composition of matter or as an article of manufacture because that DNA molecule does not occur in that isolated form in nature, or (2) synthetic DNA preparations are eligible for patents because their purified state is different from the naturally occurring compound. Patenting compositions or compounds isolated from nature follows well-established principles, and is not a new practice. For example, Louis Pasteur received U.S. Patent 141,072 in 1873, claiming '[y]least, free from organic germs of disease, as an article of manufacture.' Another example is an early patent for adrenaline. In a decision finding the patent valid, the court explained that compounds isolated from nature are patentable: 'even if it were merely an extracted product without change, there is no rule that such products are not

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patentable. Takamine was the first to make it [adrenaline] available for any use by removing it from the other gland-tissue in which it was found, and, while it is of course possible logically to call this a purification of the principle, it became for every practical purpose a new thing commercially and therapeutically. That was a good ground for a patent.' Parke-Davis & Co. v. H. K. Mulford Co., 189 F. 95, 103 (S.D.N.Y. 1911) (J. Learned Hand).

In a more recent case dealing with the prostaglandins PGE2 and PGE3, extracted from human or animal prostate glands, a patent examiner had rejected the claims, reasoning that 'inasmuch as the 'claimed compounds are naturally occurring' * * * they therefore 'are not new' within the connotation of the patent statute.' In re Bergstrom, 427 F.2d 1394, 1397, 166 USPQ 256, 259 (CCPA 1970). The Court reversed the Patent Office and explained the error: 'what appellants claim pure PGE2 and PGE3 is not 'naturally occurring.' Those compounds, as far as the record establishes, do not exist in nature in pure form, and appellants have neither merely discovered, nor claimed sufficiently broadly to encompass, what has previously existed in fact in nature's storehouse, albeit unknown, or what has previously been known to exist.' Id. at 1401, 166 USPQ at 261-62. Like other chemical compounds, DNA molecules are eligible for patents when isolated from their natural state and purified or when synthesized in a laboratory from chemical starting materials.

A patent on a gene covers the isolated and purified gene but does not cover the gene as it occurs in nature. Thus, the concern that a person whose body 'includes' a patented gene could infringe the patent is misfounded. The body does not contain the patented, isolated and purified gene because genes in the body are not in the patented, isolated and purified form. When the patent issued for purified adrenaline about one hundred years ago, people did not infringe the patent merely because their bodies naturally included unpurified adrenaline.

(3) Comment: Several comments suggested that the USPTO should seek guidance from Congress as to whether naturally occurring genetic sequences are patentable subject matter. Response: The suggestion is not adopted. Congress adopted the current statute defining patentable subject matter (35 U.S.C. 101) in 1952. The legislative history indicates that Congress intended 'anything under the sun that is made by man' to be eligible for patenting. S. Rep. No. 1979, 82d Cong., 2d Sess., 5 (1952); H.R. Rep. No. 1923, 82d Cong., 2d Sess., 6 (1952). The Supreme Court interprets the statute to cover a 'nonnaturally occurring manufacture or composition of matter-a product of human ingenuity.' Diamond v. Chakrabarty, 447 U.S. 303, 309, 206 USPQ 193, 197 (1980). Thus, the intent of Congress with regard to patent eligibility for chemical compounds has already been determined: DNA compounds having naturally occurring sequences are eligible for patenting when isolated from their natural state and purified, and when the application meets the statutory criteria for patentability. The genetic sequence data represented by strings of the letters A, T, C and G alone is raw, fundamental sequence data, i.e., nonfunctional descriptive information. While descriptive sequence information alone is not patentable subject matter, a new and useful purified and isolated DNA compound described by the sequence is eligible for patenting, subject to satisfying the other criteria for patentability.

(4) Comment: Several comments state that patents should not issue for genes because the sequence of the human genome is at the core of what it means to be human and no person should be able to own/control something so basic. Other comments stated that patents should be for marketable inventions and not for discoveries in nature. Response: The comments are not adopted. Patents do not confer ownership of genes, genetic information, or sequences. The patent system promotes progress by securing a complete disclosure of an invention to the public, in exchange for the inventor's legal right to exclude other people from making, using, offering for sale,